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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,448	06/04/2001	Patrick Midoux	USB98ASIDM	3117

466 7590 09/24/2002

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EXAMINER

SCHNIZER, RICHARD A

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 09/24/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/857,448

Applicant(s)

MIDOUX ET AL.

Examiner

Richard Schnizer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-8, 17, and 18, drawn to an oligomeric conjugate.

Group II, claim(s) 9, 10, 17, and 19, drawn to a composition comprising an oligomeric conjugate and a peptide.

Group III, claim(s) 9, 10, 17, and 19, drawn to a composition comprising an oligomeric conjugate and an oligoside.

Group IV, claim(s) 9, 10, 17, and 19, drawn to a composition comprising an oligomeric conjugate and an oligonucleotide.

Group V, claims 9, 10, 17, and 19 a composition comprising an oligomeric conjugate and a mixture of an oligonucleotide, an oligoside, and a peptide.

Group VI, claims 11-14, drawn to an in vivo process for transfer into a cell of an oligonucleotide to a cell cytosol or nucleus.

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Group VII, claims 11-14, drawn to an in vitro or ex vivo process for transfer into a cell of an oligonucleotide to a cell cytosol or nucleus.

Group VIII, claims 11-13 and 15, drawn to an in vivo process for transfer into a cell of a peptide.

Group IX, claims 11-13 and 15, drawn to an in vitro or ex vivo process for transfer into a cell of a peptide.

Group X, claims 11-13 and 16, drawn to an in vivo process for transfer into a cell of an oligoside.

Group XI, claims 11-13 and 16, drawn to an in vitro or ex vivo process for transfer into a cell of an oligoside.

Group XII, claims 11-16 drawn to an in vivo process for transfer into a cell of a composition comprising an oligomeric conjugate and a mixture of an oligonucleotide, an oligoside, and a peptide.

Group XIII, claims 11-16 drawn to in vitro or ex vivo process for transfer into a cell of a composition comprising an oligomeric conjugate and a mixture of an oligonucleotide, an oligoside, and a peptide.

Group XIV, claim 18, drawn to a method of treating a disease by administering an oligomeric conjugate.

Group XV, claim 18, drawn to a method of treating a disease by administering a composition comprising an oligomeric conjugate and a peptide.

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Group XVI, claim 18, drawn to a method of treating a disease by administering a composition comprising an oligomeric conjugate and an oligoside.

Group XVII, claim 18, drawn to a method of treating a disease by administering a composition comprising an oligomeric conjugate and an oligonucleotide.

Group XVIII, claim 18, drawn to a method of treating a disease by administering a composition comprising an oligomeric conjugate and a mixture of an oligonucleotide, an oligoside, and a peptide.

Claims 9, 10, and 19 are generic to a plurality of disclosed patentably distinct inventions in groups II-V. Claim 17 is generic to a plurality of disclosed patentably distinct inventions in groups I-V. Claims 11-13 are generic to a plurality of disclosed patentably distinct inventions in groups VI-XIII. Claim 14 is generic to a plurality of disclosed patentably distinct inventions in groups VI, VII, XII, and XIII. Claim 15 is generic to a plurality of disclosed patentably distinct inventions in groups VII, IX, XII, and XIII. Claim 16 is generic to groups X-XIII. Claim 18 is generic to a plurality of disclosed patentably distinct inventions in groups XIV-XVIII.

If a group containing any of these claims is elected, the claims will be examined to the extent that they are defined by the elected group.

The inventions listed as Groups I-XVII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons.

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The technical feature linking the inventions is an oligomeric conjugate with the characteristics described in claim 1. However, such a conjugate was taught in the prior art. See WO 98/22610 (of record), claim 1, and page 15 of the disclosure, which teach an oligomeric conjugate having a polymerization degree from 15 to 900, wherein 10-90% of the free NH<sub>3</sub> groups of monomeric substituents are substituted by residues protonatable in a weak base. Because the technical feature linking the inventions does not constitute a contribution over the prior art, it cannot serve as a special technical feature under PCT Rule 13.2.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Any inquiry concerning this communication or earlier communications from the examiner(s) should be directed to Richard Schnizer, whose telephone number is 703-306-5441. The examiner can normally be reached Monday through Friday between the hours of 6:20 AM and 3:50 PM. The examiner is off on alternate Fridays, but is sometimes in the office anyway.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Leguyader, can be reached at 703-308-0447. The FAX numbers for art unit 1632 are 703-308-4242, and 703-305-3014. Additionally correspondence can be transmitted to the following RIGHTFAX numbers: 703-872-9306 for correspondence before final rejection, and 703-872-9307 for correspondence after final rejection.

Inquiries of a general nature or relating to the status of the application should be directed to the Patent Analyst Trina Turner whose telephone number is 703-305-3413.

Richard Schnizer, Ph.D.



**JAMES KETTER  
PRIMARY EXAMINER**